REMARKS

Claims 1-32 are currently pending in the application. Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

35 U.S.C. § 103 Rejection

Claims 1-32 (incorrectly listed as 1-19) were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,029,195 to HERZ ("HERZ") alone. Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1 recites, in pertinent part:

that the similarity factors of the advisee are not calculated with respect to all   users for every individual recommendation request.

Independent claim 7 recites, in pertinent part:

that the system updates only similarity factors between neighboring users and an advisee when a new rating is entered for at least one advisee profile and utilizes an algorithm to determine a ranked matching list of the neighboring users.

Independent claim 8 recites, in pertinent part:

that the method determines the similarity factors between the advisee and the neighboring users only for the items of the selected item list.

Independent claim 32 recites, in pertinent part:

temporarily calculating, for use within a recommendation request only, a   multitude of similarity factors measuring the similarity between the advisee and the multitude of other users.

Independent claim 1

In addition to the arguments made of record previously in this case (which are herein incorporated by reference), Applicant submits that HERZ fails to disclose or suggest that the

similarity factors of the advisee are not calculated with respect to all users for every individual

recommendation request.

While Applicant acknowledges that col. 22, lines 50-55 explains that users can be

assigned attribute weights and that the system can utilize a "distance measure" in the filtering the

number of users as well as that the system can use clustering to make the search more efficient

(see col. 25, lines 45-62 and col. 26, lines 1-5), step 1205 of Fig. 12 and col. 26, lines 11-17 of

HERZ makes clear that the system considers in the computation "relevant feedback from all

users" and "considers all subclusters" .

As such, it is submitted that HERZ fails to disclose or suggest that the similarity factors

of the advisee <u>are not calculated with respect to all users</u> for every individual recommendation

request (claim 1).

The Examiner's assertion, on page 7 of the instant Office Action, that col. 6, lines 34-39

of HERZ renders obvious the feature that the similarity factors of the advisee <u>are not calculated</u>

<u>with respect to all users</u> for every individual recommendation request (claim 1) is unpersuasive.

Col. 6, lines 34-39 of HERZ merely states the following:

> Accordingly, like other target objects, users (or user pseudonyms) in accordance with
> their user profiles (or portions of which they have disclosed) may be organized and
> browsed within an automatically generated menu tree, which is below described in detail.

It is apparent from a fair reading of the noted language that it is entirely unrelated and

silent with regard to calculating similarity factors, much less, that the similarity factors of the

advisee <u>are not calculated with respect to all users</u> for every individual recommendation request

(claim 1).

Applicant also refers the Examiner to the attached decision in *Ex parte BAUDENDISTEL* which, although a non-precedential decision, explains that claim terms must be interpreted "consistent with applicants' specification" (see page 6 of the opinion). Thus, it would not be proper to construe the system of HERZ, which considers in the computation "relevant feedback from all users" and "considers all subclusters" to disclose or suggest that the similarity factors of the advisee <u>are not calculated with respect to all users</u> for every individual recommendation request (claim 1).

Furthermore, to the extent that the Examiner believes that he may construe the language of claim 1 "broadly" to encompass the disclosed system of HERZ, Applicant reminds the Examiner that the "broadest reasonable interpretation" standard must be one that "would be understood by one of ordinary skill in the art, taking into consideration the description <u>of the applicant's specification</u>. *In re Morris*, 127 F.3D 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)". See page 3 of the attached non-precedential decision *Ex parte HADDAD*. The specification describes, on paragraph [0056] of the instant published application No. 2002/0178057, the following:

> ... instead of updating the similarity factors between a rating user and every other user of the system (which has computational order of $n.\sup2$), <u>only the similarity factors between the rating user and the rating user's neighbors, as well as the similarity factors between the rating user and the neighbors of the rating user's neighbors are updated</u>. This limits the number of user profiles which must be compared to $m.\sup2$ minus any degree of user overlap between the neighbor sets where m is a number smaller than n (emphasis added).

As such, it is submitted that claim 1 must be interpreted to require (which HERZ clearly fails to disclose or suggest) that the similarity factors of the advisee <u>are not calculated with respect to all users</u> for every individual recommendation request (claim 1).

Additionally, to the extent that the Examiner believes that the system disclosed in HERZ is capable of functioning such that the similarity factors of the advisee <u>are not calculated with respect to all users</u> for every individual recommendation request (claim 1), Applicant submits that the Examiner has failed to identify the disclosed "structure which is capable of performing the recited functional limitations" (see pages 4 and 5 of non-precedential decision *Ex parte ZDEPSKI*). Certainly, the language identified by the Examiner in HERZ has not been shown by the Examiner, or by the actual disclosure of HERZ, to be capable of functioning such that the similarity factors of the advisee <u>are not calculated with respect to all users</u> for every individual recommendation request (claim 1),

Finally, Applicant also reminds the Examiner that this is a significant feature of the invention, as discussed on paragraph [0070] of the instant published application reproduced below:

> [0070] The similarity factors of the advisee do not necessarily need to be calculated with respect to all other users for every individual recommendation request. Of course the current teaching may be combined with a caching approach wherein similarity factors and neighboring users may be temporarily stored within a cache storage. If a next recommendation request has a need for data available within the cache, it could make use of this information (if the information is still up to date) without recomputation. This embodiment of the current invention enhanced by a cache is fundamentally different from the state of the art as it does not rely on the persistently precomputed similarity factors between each pair of users.

Accordingly, Applicant submits that claim 1 is not unpatentable by any proper reading of HERZ.

Independent claim 7

In addition to the arguments made of record previously in this case (which are herein

incorporated by reference), Applicant submits that HERZ fails to disclose or suggest that the

system updates only the similarity factors between neighboring users and an advisee when a new

rating is entered for at least one advisee profile and utilizes an algorithm to determine a ranked

matching list of the neighboring users.

While Applicant acknowledges that that the system can use an algorithm and clustering to

make the search more efficient (see col. 25, lines 45-62 and col. 26, lines 1-5), step 1205 of Fig.

12 and col. 26, lines 11-17 of HERZ makes clear that the system considers in the computation

"relevant feedback from all users" and "considers all subclusters" .

As such, it is submitted that HERZ fails to disclose or suggest that the system updates

only the similarity factors between neighboring users and an advisee when a new rating is entered

for at least one advisee profile and utilizes an algorithm to determine a ranked matching list of

the neighboring users (claim 7).

The Examiner's assertion, on page 9 of the instant Office Action, that col. 6, lines 34-39

of HERZ renders obvious the feature that the system updates _only the similarity factors between_

neighboring users and an advisee when a new rating is entered for at least one advisee profile and

utilizes an algorithm to determine a ranked matching list of the neighboring users (claim 7) is

unpersuasive. Col. 6, lines 34-39 of HERZ merely states the following:

> Accordingly, like other target objects, users (or user pseudonyms) in accordance with
> their user profiles (or portions of which they have disclosed) may be organized and
> browsed within an automatically generated menu tree, which is below described in detail.

It is apparent from a fair reading of the noted language that it is entirely unrelated and silent with regard to calculating similarity factors, much less, that the system updates only the similarity factors between neighboring users and an advisee when a new rating is entered for at least one advisee profile and utilizes an algorithm to determine a ranked matching list of the neighboring users (claim 7).

Again, to the extent that the Examiner believes that he may construe the language of claim 1 "broadly" to encompass the disclosed system of HERZ, Applicant reminds the Examiner that the "broadest reasonable interpretation" standard must be one that "would be understood by one of ordinary skill in the art, taking into consideration the description of the applicant's specification. *In re Morris*, 127 F.3D 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)". See page 3 of the attached non-precedential decision *Ex parte HADDAD*. This has clearly not been done in this case.

Accordingly, Applicant submits that claim 7 is not unpatentable by any proper reading of HERZ.

Independent claim 8

In addition to the arguments made of record previously in this case (which are herein incorporated by reference), Applicant submits that HERZ fails to disclose or suggest that the method determines the similarity factors between the advisee and the neighboring users only for the items of the selected item list.

Again, while Applicant acknowledges that that the system uses clustering to make the search more efficient (see col. 25, lines 45-62 and col. 26, lines 1-5), step 1205 of Fig. 12 and

col. 26, lines 11-17 of HERZ makes clear that the system considers in the computation "relevant feedback from all users" and "considers all subclusters".

As such, it is submitted that HERZ fails to disclose or suggest that the method determines the similarity factors between the advisee and the neighboring users <u>only for the items of the selected item list</u> (claim 8).

The Examiner's assertion, on page 12 of the instant Office Action, that col. 6, lines 34-39 of HERZ renders obvious the feature that the method determines the similarity factors between the advisee and the neighboring users <u>only for the items of the selected item list</u> (claim 8) is unpersuasive. Col. 6, lines 34-39 of HERZ merely states the following:

> Accordingly, like other target objects, users (or user pseudonyms) in accordance with their user profiles (or portions of which they have disclosed) may be organized and browsed within an automatically generated menu tree, which is below described in detail.

It is apparent from a fair reading of the noted language that it is entirely unrelated and silent with regard to calculating similarity factors, much less, that the method determines the similarity factors between the advisee and the neighboring users <u>only for the items of the selected item list</u> (claim 8).

Again, to the extent that the Examiner believes that he may construe the language of claim 1 "broadly" to encompass the disclosed system of HERZ, Applicant reminds the Examiner that the "broadest reasonable interpretation" standard must be one that "would be understood by one of ordinary skill in the art, taking into consideration the description <u>of the applicant's specification.</u> *In re Morris*, 127 F.3D 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)". See page 3 of the attached non-precedential decision *Ex parte HADDAD*. This has clearly not been done in this case.

Accordingly, Applicant submits that claim 8 is not unpatentable by any proper reading of

HERZ.

Independent claim 32

Applicant initially notes that the specific features of claim 32 were not addressed in the

Final Rejection. Instead, the Examiner lumps claim 32 with claim 1 as if they recite the same

features and fails to mention the specific differences between claims 1 and 32.

However, claim 32 does not recite the same features of claim 1. For example, claim 32

recites <u>temporarily calculating</u>, for use within a recommendation request only, a multitude of

similarity factors measuring the similarity between the advisee and the multitude of other users as

well as <u>determining a subset</u>, from the multitude of users, of neighboring users nearest the

advisee as determined by the similarity factors. These features <u>have not even been mentioned</u> in

the Final Rejection, much less, shown to be disclosed or suggested by HERZ.

As explained above, the Examiner's opinion that col. 6, lines 34-39 of HERZ renders

obvious the feature recommending at least one item based on the similarity factors of the

neighboring users and based on rating values of the items by the neighboring users (claim 32) is

unpersuasive. Col. 6, lines 34-39 of HERZ merely states the following:

> Accordingly, like other target objects, users (or user pseudonyms) in accordance with
> their user profiles (or portions of which they have disclosed) may be organized and
> browsed within an automatically generated menu tree, which is below described in detail.

It is apparent from a fair reading of the noted language that it is entirely unrelated and

silent with regard to similarity factors, much less, recommending at least one item based on the

similarity factors of the neighboring users and based on rating values of the items by the

neighboring users (claim 32).

Moreover, Applicant submits that, at best, the Examiner has merely identified broad passages of HERZ without providing "any citation specifically addressing" each claim limitation and that this is entirely improper. This is improper. See page 8 of non-precedential decision *Ex parte HUA*.

As such, it is submitted that HERZ fails to disclose or suggest temporarily calculating, for use within a recommendation request only, a multitude of similarity factors measuring the similarity between the advisee and the multitude of other users as well as determining a subset, from the multitude of users, of neighboring users nearest the advisee as determined by the similarity factors (claim 32).

Because at least claims 1, 7, 8 and 32 each recite one of more features not disclosed, or even suggested, by HERZ, and because the Examiner has failed to set forth any prior art which teaches the missing features, Applicant submits that the instant rejection of claims 1-32 should be withdrawn.
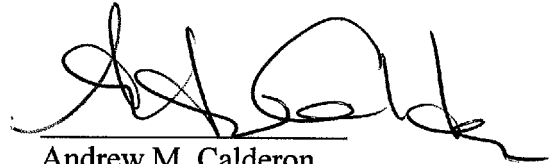
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required.

Please charge any deficiencies in fees and credit any overpayment of fees to Deposit

Account No.09-0457.

Respectfully submitted,
Ralf BERTRAM, *et al.*

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Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS A. BAUDENDISTEL, SANJIV G. TEWANI, MARK W. LONG,
JAMES E. DINGLE, LARRY M. OBERDIER, and DAVID K. LAMBERT

Appeal No. 2004-1553
Application No. 09/915,631

ON BRIEF

Before FRANKFORT, STAAB, and FLEMING, _Administrative Patent Judges_.

STAAB, _Administrative Patent Judge_.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-20, all the claims currently pending in the application.

Appellants' invention pertains to a powertrain mount having a capacitive displacement sensor. As explained on pages 3-4 of appellants' specification, an output signal of the sensor is

utilized by a control device to adjust the damping

characteristics of the mount. A further understanding of the

invention can be derived from a reading of exemplary claims 1 and

19.

The sole reference applied by the examiner in the final

rejection is:

Yamakado et al. (Yamakado)   5,726,886   Mar. 10, 1998

Claims 1-20 stand rejected under 35 U.S.C. § 102(b) as being

anticipated by Yamakado.

Reference is made to appellants' main and reply briefs

(Paper Nos. 7 and 9) and to the examiner's final rejection and

answer (Paper Nos. 5 and 8) for the respective positions of

appellants and the examiner regarding the merits of this

rejection.

Discussion

Independent claims 1 and 10 are directed to a mount for a

powertrain component of a motor vehicle comprising, among other

things, a first plate "connected to" one of the powertrain

component or a frame of the motor vehicle, and a second plate

"connected to" the other of the powertrain component or the frame

of the motor vehicle.

Claim 19, the only other independent claim on appeal, is
directed to a system for controlling the damping characteristics
of a motor vehicle powertrain mount comprising, among other
things, a first positively charged plate "fixed relative to" one
of the powertrain component or the frame of the motor vehicle,
and a second, negatively charged plate "fixed relative to" the
other of the powertrain component or the frame of the motor
vehicle.

Yamakado, the alleged anticipatory reference, is directed,
in pertinent part, to mounting devices for mounting a vehicle
engine to a chassis wherein the mounting devices are controlled
in dependence on the differential of acceleration of the engine,
thereby to smooth the transmission of power from the engine
(column 2, lines 54-60). With reference to Figure 17, a sensor
163 for measuring the differential of acceleration is mounted on
an engine 161, the engine being supported by engine mounts 162a
and 162b. The acceleration differential sensor 163 supplies a
signal to a controller 167 which in turn controls the engine
mounts 162a, 162b, presumably by changing the damping
characteristics of the mounts. Figure 4 shows the configuration
of a first embodiment of an acceleration differential sensor that
may be used in the system of Figure 17. The Figure 4 sensor

consists of a pendulum **1** attached to a casing **10a** using
a joint **13** providing one degree of freedom of movement
(i.e.[,] the pendulum **1** is constrained to move in one
plane only). A coil **3** is fixed to the pendulum **1**, and
a movable electrode **41** is attached at or adjacent the
free end (moving direction) of the pendulum **1**. A
casing **10** supports a magnet **2** so that the magnet is
adjacent the coil **3**, and an electrode **42** is fixed to
the casing **10**, facing the movable electrode **41**.

. . . .

As mentioned above, the pendulum **1** has one degree
of freedom of movement (in the plane of the paper in
FIG. **4**), so the sensor detects movement, and the
differential of acceleration of that movement in that
direction. The movable electrode **41** and electrode **42**
fixed to the casing **10** form two pairs of electrodes
representing two plate capacitors. The electrostatic
capacitance C of such a plate capacitor is inversely
proportional to the size of the gap between the
capacitor plates . . . .

. . . .

. . . [T]he displacement of the pendulum **1** can be
detected from the change C in the electrostatic
capacitance between the two capacitors each formed by a
movable electrode **41** and a fixed electrode **42**. [Column
7, lines 12-48.]

In rejecting the appealed claims as being anticipated by

Yamakado, the examiner reads the claimed first plate on the

movable electrode 41 of Yamakado's sensor and the claimed second

plate on the fixed electrode 42 of Yamakado's sensor. With

respect to the "connected to" limitations of independent claims

1 and 10, the examiner contends (answer, page 5)

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that plate 42 of the reference is in fact connected to
a frame . . . . [P]late 42, while not being directly
connected to the frame of the assembly (the frame being
the portion located directly below the engine mounts),
is indirectly connected to the frame at least through
the controller component 167 and engine mounts 162a and
162b or subsequently, indirectly connected through the
engine 161 and the engine mounts.

Therefore, since applicant has not claimed that
the second plate 42 is directly connected to a frame,
this limitation is met by Yamakado et al.

Concerning the "fixed relative to" limitations of

independent claim 19, the examiner takes the position (answer,

page 6)

that plate 41 of the reference is fixed, at least to
some extent, to the powertrain component 161. As
discussed in column 7[,] lines 11-15 of the reference,
at least through joint 13, the pendulum 1, in which
plate 41 is attached thereto, can only move in one
direction, therefore plate 41 is fixed, at least
somewhat, with respect to the powertrain equivalent
component 161, i.e., fixed in the directions/planes the
pendulum 1 is not allowed to move in.

Appellants argue (brief, pages 4-5) that the examiner is in

error in asserting that the second plate 42 of Yamakado is

"connected to" the frame of the vehicle and in asserting that the

first plate 41 of Yamakado is "fixed relative to" one of the

powertrain component or frame of the vehicle.

5

In general, words in a claim will be given their ordinary

and accustomed meaning, unless it appears that the inventor used

them differently, *Envirotech Corp. v. Al George, Inc.* 730 F.2d

753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984), and a claim will be

given its broadest reasonable interpretation, consistent with the

specification. *In re Prater,* 415 F.2d 1393, 1404, 162 USPQ 541,

550 (CCPA 1969). Considering first the examiner's treatment of

independent claims 1 and 10, the dictionary[1] contains several

definitions of the verb "connect." Consistent with appellants'

specification[2], and as normally applied in the structural sense,

we consider that the claim terminology calling for a plate

"connected to" a component or frame to connote a plate that is

"joined or fastened together" with a component or frame, which is

the past tense equivalent of a dictionary definition of the verb

"connect." While we acknowledge that the verb "connect" may also

mean "to associate or relate," we do not consider this broader

definition to be the appropriate broadest reasonable

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[1]*Webster's II New Riverside University Dictionary,* copyright
© 1984 by Houghton Mifflin Company.

[2]See page 3, lines 8-12, of the specification, where the
mount assembly is described as being attached to the engine or
transmission by a first fastener 14 and attached to the vehicle
frame by a second fastener 15 such that the mount is interposed
between the engine or transmission and the frame.

interpretation of the term "connected" as used in appealed claims 1 and 10 when the claims are read in light of appellants' specification. Based on this claim interpretation, we cannot support the examiner's strained position to the effect that plate 42 of Yamakado is indirectly connected to the vehicle frame through either the controller component 167 and the engine mounts 162a and 162b or, alternatively, through the engine 161 and the engine mounts.

We reach a similar conclusion with respect to the examiner's treatment of independent claim 19. Consistent with appellants' specification[3], and as normally applied in the structural sense, we consider that the claim terminology calling for a plate "fixed relative to" a component or frame to connote a plate that is "fastened" to or "made fast to" a component or frame, both of which are past tense equivalents of dictionary definitions of the verb "fix." On the other hand, we do not find any dictionary definition of the verb "fix" which would allow the phrase "fixed relative to" to encompass the sort of relationship disclosed in Figures 4 and 17 of Yamakado between either of the electrodes 41, 42 of sensor 163 and the frame of the vehicle. Based on this

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[3]*Ib.*

claim interpretation, we cannot support the examiner's equally

strained position to the effect that plate 41 of Yamakado is

fixed at least to some degree to the engine or vehicle frame due

to the circumstance that it can only move in one plane.

To summarize, we do not consider either one of the

electrodes 41, 42 of Yamakado's sensor to be either "connected

to" or "fixed relative to" the frame of the vehicle. It follows

that we cannot sustain the examiner's rejection of claims 1-20 as

being anticipated by Yamakado.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
	))))	BOARD OF PATENT
LAWRENCE J. STAAB Administrative Patent Judge	))	APPEALS AND INTERFERENCES
	)))	
MICHAEL R. FLEMING Administrative Patent Judge	))	

LJS:hh

Appeal No. 2004-1553
Application No. 09/915,631

DELPHI TECHNOLOGIES, INC.
LEGAL STAFF, MAIL CODE: 482-204-450
1450 W. LONG LAKE
P.O. BOX 5052
TROY, MI   48098

The opinion in support of the decision being entered
today was _not_ written for publication in a law journal
and is _not_ binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte NADIM HADDAD, CHARLES N. ALCORN,
JONATHAN MAIMON, LEONARD R. ROCKETT
and SCOTT DOYLE

_____

Appeal No. 2003-2013
Application No. 09/491,230

_____

ON BRIEF

_____

Before KIMLIN, JEFFREY T. SMITH and PAWLIKOWSKI, Administrative
Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

        This is an appeal from the final rejection of claims 6-19.

Claim 6 is illustrative:

6.   A resistor, comprising:

        a first passivation layer overlying a semiconductor
substrate having a plurality of transistors;

a first bottom contact and a second bottom contact formed through said first passivation layer at a first contact location and a second contact location, respectively;

a resistive film formed over said first passivation layer to serve as a resistor, wherein said resistive film has a first end and a second end;

a first top contact connecting said first bottom contact to said first end of said resistive film; and

a second top contact connecting said second bottom contact to said second end of said resistive film.

In the rejection of the appealed claims, the examiner relies

upon the following reference:

Matthews   5,182,225   Jan. 26, 1993

Appellants' claimed invention is directed to a resistor

wherein first and second top contacts connect first and second

bottom contacts to first and second ends of a resistive film.

Appealed claims 6, 7, 11, 12 and 16-19 stand rejected under

35 U.S.C. § 102(b) as being anticipated by Matthews. Claims 8-10

and 13-15 stand rejected under 35 U.S.C. § 103 as being

unpatentable over Matthews.

We have thoroughly reviewed the respective positions

advanced by appellants and the examiner. In so doing, we concur

with appellants that the prior art cited by the examiner neither

describes the claimed invention within the meaning of § 102 nor

-2-

renders it obvious within the meaning of § 103. Accordingly, we will not sustain the examiner's rejections.

The basis of the examiner's rejections over Matthews is finding that the gate and source regions of Matthews meet the requirements for the claimed first and second bottom contacts, respectively. In other words, it is the examiner's position that the gate and source of Matthews are contacts which meet the requirements of the presently claimed first and second bottom contacts. Appellants, on the other hand, contend that when one of ordinary skill in the art interprets the claim language in light of the specification, such a skilled artisan would not read the first and second bottom contacts as including the gate and source regions of Matthews.

We must acknowledge that there is a certain appeal in the examiner's position. Manifestly, the source and gate of Matthews are made of a conductive material and serve to pass current from one body to another, as urged by the examiner. However, it is well settled that claim language is given its broadest reasonable meaning during prosecution as it would be understood by one of ordinary skill in the art, taking into consideration the description of the applicant's specification. In re Morris,

127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).
In the present case, appellants' specification describes that the
contacts, or studs, are made from tungsten, aluminum, or copper,
and the specification also discloses other areas of the device as
gate and source regions (14a, 14b and 17a, 17b, respectively).
Hence, we find it reasonable to conclude that one of ordinary
skill in the art would not interpret the claimed first and second
bottom contacts as inclusive of gate and source regions and,
therefore, it is our opinion that the gate and source regions of
Matthews are not a description of the claimed bottom contacts
within the meaning of § 102. In our view, appellants' arguments
during prosecution establish, via file wrapper estoppel, that the
claimed first and second bottom contacts do not encompass gate
and source regions.

As for the examiner's § 103 rejection, the examiner has not
presented a rationale why it would have been obvious for one of
ordinary skill in the art to modify Matthews to incorporate the
claimed first and second bottom contacts in addition to the gate
and source regions.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

<u>REVERSED</u>

EDWARD C. KIMLIN Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
JEFFREY T. SMITH Administrative Patent Judge	)	BOARD OF PATENT
	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY PAWLIKOWSKI Administrative Patent Judge	)	

ECK:clm

Appeal No. 2003-2013
Application No. 09/491,230

Bracewell & Patterson, L.L.P.
Intellectual Property Law
P.O. Box 969
Austin, TX   78767-0969

The opinion in support of the decision being entered today was
<u>not</u> written for publication and is <u>not</u> binding precedent of
the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

<u>Ex parte</u> JOEL ZDEPSKI, RAMA KALLURI, HOWARD PAGE
and WOLF-HASSO KAUBISCH

_____

Appeal No. 1999-2306
Application 08/639,284

_____

ON BRIEF

_____

Before THOMAS, HAIRSTON and JERRY SMITH, <u>Administrative Patent
Judges</u>.

JERRY SMITH, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

    This is a decision on the appeal under 35 U.S.C. § 134

from the examiner's rejection of claims 1-28, which constitute

all the claims in the application. An amendment after final

rejection was filed on December 7, 1998, and was entered by

the examiner.

1

The disclosed invention pertains to a method and apparatus for generating trickplay video streams, such as fast forward and fast reverse video streams, from a compressed normal play bitstream.

Representative claim 1 is reproduced as follows:

1. A computer-implemented method for generating trickplay streams from a compressed normal play bitstream, comprising:

receiving a compressed normal play bitstream, wherein said compressed normal play bitstream includes a plurality of intracoded frames and a plurality of intercoded frames;

extracting said intracoded frames from said compressed normal play bitstream, wherein said extracting includes storing said intracoded frames in a storage memory;

assembling said intracoded frames to form an assembled bitstream after said extracting;

decoding said assembled bitstream to produce a plurality of uncompressed frames; and

encoding said plurality of uncompressed frames after said decoding to produce a compressed trick play bitstream, wherein said compressed trick play bitstream includes only a subset of frames of said normal play bitstream.

The examiner relies on the following reference:

Lane et al. (Lane)   5,623,344   Apr. 22, 1997
                                               (filed Aug. 19, 1994)

Claims 1-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Lane.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of Lane fully meets the invention as set forth in claims 18, 20 and 21. We reach the opposite conclusion with respect to claims 1-17, 19 and 22-28. Accordingly, we affirm-in-part.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing

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the recited functional limitations. RCA Corp. v. Applied

Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385,

388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L.

Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540,

1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469

U.S. 851 (1984).

The examiner indicates how he reads the claimed

invention on the disclosure of Lane [answer, pages 4-7].

Appellants nominally argue the rejection against the claims in

eight separate groupings [brief, page 3, reply brief, page 2].

Appellants' first grouping of claims includes claims

1, 2, 4, 5, 8-10, 12, 13, 16, 17, 25 and 26. With respect to

these claims, appellants argue that Lane does not disclose

generation of a trickplay stream at all. Appellants also

argue that Lane does not disclose the step of extracting

intracoded frames from the normal play bitstream which

includes storing the intracoded frames in a storage memory.

Appellants also argue that it is not clear that Lane forms an

assembled bitstream from the extracted intracoded frames.

Finally, appellants argue that Lane does not disclose decoding

an assembled bitstream to produce uncompressed frames and then

encoding the uncompressed frames to produce a compressed

trickplay bitstream as claimed [brief, pages 4-7].

The examiner responds that Lane teaches that D, I, B

and P frames of video data are stored and processed. The

examiner also responds that the assembled I-frames of video in

Lane form an assembled bitstream as claimed. The examiner

also responds that Lane teaches the decoding of received data

packets and an encoder for producing a compressed trickplay

bitstream as claimed [answer, pages 7-10]. Appellants respond

that there is no disclosure in Lane that the extracted I-

frames are stored. Appellants also respond that decoding

packets of data is not the same as decoding a bitstream, and

the decoding/encoding in Lane occur after the trickplay

bitstream is formed rather than before as claimed [reply

brief, pages 3-5].

With respect to the first group of claims, we agree

with the position argued by appellants. We note that Lane

appears to have two separate teachings which are relied on by

the examiner. First, Lane describes a prior art fast play

technique in which the I-frames of a sequence of a video

bitstream are extracted and assembled in a sequence. Second,

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Lane describes his own technique for fast play in which normal

and trickplay segments of data are geometrically arranged on a

videotape. The examiner refers to the prior art technique for

meeting the extracting and assembling I-frames steps of the

claimed invention but refers to Lane's technique for teaching

the decoding and encoding of this assembled bitstream. In our

view, these disparate teachings of Lane cannot be combined as

proposed by the examiner to find anticipation.

With respect to the prior art technique disclosed by

Lane, we agree with the examiner that this disclosure would

have suggested to the artisan that a trickplay bitstream could

be obtained by extracting I-frames from a normal play

bitstream and assembling these I-frames in sequence. We also

agree with the examiner that the disclosure in Lane would have

suggested to the artisan that the extracted I-frames are

stored. The person familiar with this art would have

understood that bitstream frames in the prior art could be

stored before they are processed. Lane's disclosure that the

D-frames of MPEG compression are stored separately from the

normal MPEG bitstream is sufficient to anticipate the storage

of such frames as argued by the examiner. Lane, however,

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teaches nothing about performing any further operations on the
assembled I-frames. As noted above, the decoding and encoding
steps of Lane which are relied on by the examiner have nothing
to do with this prior art technique of assembling I-frames.
The fact that encoding and decoding steps were known in a
different embodiment does not anticipate applying these steps
to the prior art embodiment of Lane.

Since we find that the decoding and encoding steps of
Lane are not applicable to the prior art I-frames sequencing
disclosed by Lane, we do not sustain the examiner's rejection
of claims 1, 2, 4, 5, 8-10, 12, 13, 16, 17, 25 and 26. Since
we have not sustained the rejection with respect to
independent claims 1, 9, 17 and 26, we also do not sustain the
anticipation rejection with respect to dependent claims 3, 6,
7, 11, 14, 15 and 27.

We now consider independent claim 18. Claim 18 is the
same as claim 1 except that the final decoding and encoding
steps are replaced by the step of storing the assembled
bitstream. Appellants' only additional argument with respect
to claim 18 is that Lane does not teach that the assembled
bitstream is stored. As discussed above, however, we agree

with the examiner that Lane teaches that frames of a bitstream are stored. We find that this teaching extends to bitstreams which are in frame form such as D, I, B and P frames or frames which have been assembled in sequence such as the I-frames taught by Lane. The decoding and encoding steps of claim 1 which were found not anticipated by Lane are not present in claim 18. Thus, we agree with the examiner that the invention of claim 18 is fully met by the disclosure of Lane.

The fact that Lane indicates that the prior art technique would have difficult problems to overcome does not eliminate this disclosure as a valid reference. The prior art does not indicate that the problems cannot be solved, only that the problems are difficult to solve. Anticipation would not be defeated by merely arguing the level of difficulty involved unless it could be shown that the teaching relied on was not enabling. Such a showing is not present here. Therefore, we sustain the rejection of claim 18 and of claims 20 and 21 which are grouped therewith.

Claim 19, which depends from 18, is separately argued. Appellants argue that Lane relates to actions performed on packet headers rather than bitstream sequence headers as

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claimed. The examiner disagrees with appellants and points to the operation of Lane's preferred embodiment.

As noted above, we find that Lane's preferred embodiment has nothing to do with the prior art embodiment also disclosed by Lane. Therefore, the headers of the data packets in Lane have nothing to do with bitstream sequence headers sent along with I-frames. The admitted prior art of Lane does not indicate how the I-frames are to be extracted from the normal bitstream or what specific information is to be extracted and assembled. Therefore, we agree with appellants that Lane does not disclose the extraction of sequence headers from a bitstream and the assembling of sequence headers along with the I-frames to form an assembled bitstream as recited in claim 19. Therefore, we do not sustain the examiner's rejection of claim 19.

Claims 22 and 23 are separately argued by appellants. These claims recite that matrices in the normal bitstream are located and included in the assembled bitstream. Appellants argue that there is no disclosure of matrices in Lane. The examiner responds that digitized video signals in the MPEG format are known to include matrices and the assembly of a

sequence of I-frames would include these matrices.

We agree with appellants. As noted above, Lane discloses nothing about how to extract the I-frames from the normal bitstream and how to assemble these I-frames in sequence. The admitted prior art in Lane does not indicate that matrices are to be located and assembled in forming the I-frames bitstream in the prior art. Therefore, we do not sustain the examiner's rejection of claims 22 and 23.

Claims 24 and 25 are separately argued by appellants. Since these claims include the decoding and encoding steps as discussed above with respect to claim 1, we do not sustain the examiner's rejection of claims 24 and 25.

Claim 28 is separately argued by appellants. Specifically, appellants argue that Lane does not disclose the recited use of a memory stack to store and retrieve markers and coordinates in response to finding start codes for data blocks, extension blocks and I-frame headers. The examiner finds that the steps of claim 28 are inherently performed in Lane. Appellants dispute this finding.

We agree with appellants. The disclosure of Lane does not support the examiner's findings of anticipation. Claim 28

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recites a plurality of steps which are clearly not disclosed by Lane and cannot properly be considered to be inherently performed in Lane. Therefore, we do not sustain the examiner's rejection of claim 28.

In summary, we have sustained the examiner's anticipation rejection with respect to claims 18, 20 and 21, but we have not sustained the rejection with respect to each of the other claims on appeal. Therefore, the decision of the examiner rejecting claims 1-28 is affirmed-in-part.

Appeal No. 1999-2306
Application 08/639,284

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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                                          )
        JAMES D. THOMAS                    )
        Administrative Patent Judge        )
                                          )
                                          )
                                          ) BOARD OF PATENT
        KENNETH W. HAIRSTON                    )
        Administrative Patent Judge        )    APPEALS AND
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                                          ) INTERFERENCES
                                          )
        JERRY SMITH                        )
        Administrative Patent Judge        )
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MORGAN HUA and JOSE MACHUCA

_____

Appeal 2007-1762
Application 10/218,245
Technology Center 2100

_____

Decided: August 28, 2007

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Before JAMES D. THOMAS, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the

Examiner's rejection of claims 2, 8, 14, 19-23, 25-33, 35-38, 40-45 and 47.[1]

We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

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[1] To consolidate the issues on appeal, Appellants have withdrawn claim 14
from consideration in this appeal (Br. 4). Therefore, the appeal is dismissed
as to this claim.

In addition, we *sua sponte* set forth new grounds of rejection under 35 U.S.C. § 101 for claims 2, 8 and 44, and under 35 U.S.C. § 112, second paragraph, for claims 19-23, 25-33, 35-38, 40-45 and 47, pursuant to our authority under 37 C.F.R § 41.50(b).

THE INVENTION

The disclosed invention generally relates to a system and method for synchronizing contact information, such as an email address, between two storage locations. The invention allows a plurality of merchants or service providers to synchronize contact information for individual customers, keeping the contact information updated, even when users change their contact information and neglect to inform the service provider or merchant (Specification 1-3).

Independent claims 2 and 19 are illustrative:

2.   A method for synchronizing a first e-mail address of a user in an authentication proxy and a second e-mail address of said user in an integrated authorized site of said authentication proxy, said method comprising the steps of:

(a) checking status of said first e-mail address and said second e-mail address;

(b) if said first e-mail address is blank and said second e-mail address is set, then copying said second e-mail address and a confirm status of said second e-mail address to said authentication proxy site;

(c) if said first e-mail address is set but said second e-mail address is blank, then copying said first e-mail address to said integrated authorized site and confirming e-mail address change to said first e-mail address;

(d) if both said first e-mail address and said second e-mail address are blank, then keeping said first e-mail address blank and a confirm status of said first e-mail address NULL;

(e) if both said first e-mail address and said second e-mail address are set, then checking whether said first e-mail address is the same as said second e-mail address;

(e1) if said first e-mail address is the same as said second e-mail address, then copying said confirm status of said second e-mail address to said authentication proxy; and

(e2) if said first e-mail address is not the same as said second e-mail address, then providing means for prompting said user to choose among said first e-mail address and said second e-mail address, or specify a synchronized e-mail address through a graphical interface;

wherein said status of said new e-mail address can be any of: confirm; unconfirm; and NULL.

19.   A method for registering a user of an authentication proxy to a partner site of said authentication proxy while keeping profile of said user synchronized, comprising the steps of:

said user registering at said partner site;

said user changing profile fields other than e-mail address;

synchronizing said changed profile fields with said authentication proxy;

said user entering a new e-mail address while a confirm status of said e-mail address is change pending; and

displaying a message to said user that said new e-mail address is to be sent to said partner site but not to said authentication proxy.

THE REFERENCES

Togawa	US 2002/0004821 A1	Jan. 10, 2002 (filed Mar. 28, 2001)
Bilbrey	US 2002/0103932 A1	Aug. 1, 2002 (filed Aug. 3, 2001)

THE REJECTIONS

1. Claims 2, 20-23, 29-33, 36-38, and 41-43 stand rejected under 35 U.S.C. § 112, first paragraph.

2. Claims 2, 8, 19, 21, 22, 35, 37, 38, 40, 42, and 43 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Togawa.[2]

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[2] We note that claim 21 (rejected under § 102 as being anticipated by Togawa) depends upon claim 20 (rejected under §103 as being obvious over Togawa). It is improper to apply a § 102 rejection (i.e., anticipated by Togawa) to a claim that depends upon another claim rejected under §103 as being obvious over Togawa. Because claim 22 depends upon claim 21, and claim 23 depends upon claim 22, we find at the outset that dependent claims 21-23 have been improperly rejected by the Examiner. Likewise, claim 37 (rejected under §102 as being anticipated by Togawa) depends upon claim 36 (rejected under §103 as being obvious over Togawa). Because claim 38 depends upon claim 37, we also find that dependent claims 37 and 38 have been improperly rejected by the Examiner. Similarly, claim 42 (rejected under §102 as being anticipated by Togawa) depends upon claim 41 (rejected under §103 as being obvious over Togawa). Because claim 43

3. Claims 44 and 45 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Bilbrey.[3]

4. Claims 25-33 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Bilbrey.

5. Claims 20, 23, 36, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Togawa.[4]

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs, the Final Action, and the Answer for the respective details thereof.

Enablement under 35 U.S.C. § 112, first paragraph

We consider first the Examiner's rejection of claims 2, 20-23, 29-33, 36-38, and 41-43 as being based on a disclosure which is not enabling. The Examiner argues that limitation (d) of claim 2 "appears to be an impossible situation because synchronizing two e-mail addresses that do not exist simply would not occur in the system that Applicant describes as their

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depends upon claim 42, we also find that dependent claims 42 and 43 have been improperly rejected by the Examiner. Therefore, we *pro forma* reverse the Examiner's rejection of claims 21, 22, 37, 38, 42, and 43 as being anticipated by Togawa and we reverse the Examiner's rejection of claim 23 as being unpatentable over Togawa.

[3] The Examiner indicates that claim 14 is also rejected under this rationale (Answer 5). However, claim 14 has been withdrawn from consideration in this appeal by Appellants (Br. 4).

[4] *See* Footnote 2 which explains why dependent claim 23 has been improperly rejected by the Examiner.

invention"[5] (Answer 11). Regarding claim 2, Appellants argue that the claim language does not require user-initiated synchronization (Br. 13-14). Appellants further argue that this step would occur in the claimed system, and commonly occurs in other systems, such as when banks and credit agencies synchronize information about users without user initiation (Br. 14 ¶ 3).

Our reviewing court has determined that "[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (citation omitted). Furthermore, "[t]he specification need not disclose what is well known in the art." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) (citation omitted).

When we look to the instant Specification, we find adequate disclosure to enable one reasonably skilled in the art to make and use the invention without undue experimentation, as clearly shown in Fig. 2 (i.e., block 205 and the decision block to the left of block 205) and as discussed on page 12, lines 1-3. Therefore, we will reverse the Examiner's rejection of claims 2, 20-23, 29-33, 36-38, and 41-43 as being based upon a disclosure which is not enabling.

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[5] *See* Claim 2: "(d) if both said first e-mail address and said second e-mail address are blank, then keeping said first e-mail address blank and a confirm status of said first e-mail address NULL." We note that this limitation does not appear in independent claims 19, 25, 35, 40, or 44.

Anticipation

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005) (citation omitted).

Independent claim 2

We consider next the Examiner's rejection of independent claim 2 as being anticipated by Togawa.

In rejecting claim 2, the Examiner cites to several locations in Togawa (Answer 3-4). However, as correctly noted by Appellants (Br. 20), the Examiner has not provided a citation addressing recited step (d): "if both said first e-mail address and said second e-mail address are blank, then keeping said first e-mail address blank and a "confirm status" of said first e-mail address NULL" (Claim 2). After being notified of this omission in the Brief (Br. 20), the Examiner again failed to provide any citation or explanation of how this element was treated (Answer 11-17).

Upon review of the citations proffered by the Examiner, and the entirety of the Togawa reference, we find nothing in Togawa that fairly discloses where if both the first and second e-mail addresses are blank, then keeping the first e-mail address blank and a "confirm status" of the first e-mail address NULL, as required by the language of claim 2. Therefore, we will reverse the Examiner's rejection of independent claim 2 as being anticipated by Togawa.

Dependent claim 8

We have reversed the Examiner's rejection of independent claim 2 as being anticipated by Togawa. Therefore, we will also reverse the Examiner's rejection of claim 8 as being anticipated by Togawa, as claim 8 depends from claim 2.

Independent claims 19, 35 and 40

We consider next the Examiner's rejection of independent claims 19, 35 and 40 as being anticipated by Togawa.

In rejecting independent claims 19, 35 and 40, the Examiner directly relies upon ¶ 31 of Togawa (Answer 5) and argues that the citations used in the rejection of claim 2 also address claim 19 (Answer 13).[6] Appellants argue that Togawa fails to disclose: "said user registering at said partner site" (claim 19), or "said user changing profile fields other than e-mail address" (claims 19, 35), or "said user changing a field in said profile data other than e-mail address" (claim 40) (Br. 24).

We note that the Examiner has not provided any citation specifically addressing the limitation of "said user registering at said partner site" (claim 19). We agree with Appellants that paragraph 31 of Togawa fails to disclose a user registering at a partner site or a user changing profile fields other than an e-mail address. In paragraph 31, we find the only disclosed change is made to the server name (i.e., domain name) of an e-mail address (i.e., the portion after the @ symbol in an e-mail address). Togawa merely discloses that such server name is "updated due to a provider change, a company name change, and a staff reassignment (transfer) etc." (*see* Togawa, ¶ 31).

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Upon review of the citations proffered by the Examiner in the rejection of claim 19, and the Togawa reference in its entirety, we find nothing in Togawa that fairly discloses a user registering at a partner site (*see* claim 19) or a user changing profile fields other than an e-mail address (*see* claims 19, 35, and 40).

Additionally, we note that the Examiner has not provided a citation addressing the limitation of displaying a message to the user that the new e-mail address is to be sent to the partner site but not to the authentication proxy, as required by the equivalent language of claims 19 and 35 and the similar language of 40, i.e., "displaying a message to said user that new e-mail will be sent to partner site but e-mail address at said authentication proxy unchanged" (claim 40). Upon review of the citations proffered by the Examiner in the rejection of claims 19, 35, and 40, and the Togawa reference in its entirety, we find nothing in Togawa that fairly discloses displaying such a message to the user. Therefore, we will reverse the Examiner's rejection of independent claims 19, 35 and 40 as being anticipated by Togawa.

<p style="text-align:center">Dependent claims 20-23</p>

Because we have reversed the Examiner's rejection of independent claim 19 as being anticipated by Togawa, we will also reverse the Examiner's rejection of claim 20 as being unpatentable over Togawa, as claim 20 depends from claim 19. We have *pro forma* reversed the Examiner's rejection of claims 21-23 as improper, as discussed *supra* in Footnote 2.

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[6] *See also* ¶ 22 of the Final Action mailed June 22, 2005.

Dependent claims 36-38

Because we have reversed the Examiner's rejection of independent claim 35 as being anticipated by Togawa, we will also reverse the Examiner's rejection of claim 36 as being unpatentable over Togawa, as claim 36 depends from claim 35. We have *pro forma* reversed the Examiner's rejection of claims 37 and 38 as improper, as discussed *supra* in Footnote 2.

Dependent claims 41-43

Because we have reversed the Examiner's rejection of independent claim 40 as being anticipated by Togawa, we will also reverse the Examiner's rejection of claim 41 as being unpatentable over Togawa, as claim 41 depends from claim 40. We have *pro forma* reversed the Examiner's rejection of claims 42 and 43 as improper, as discussed *supra* in Footnote 2.

Claims 44 and 45

We consider next the Examiner's rejection of claims 44 and 45 as being anticipated by Bilbrey.

In rejecting independent claim 44, the Examiner cites to several paragraphs of Bilbrey between paragraphs 92 and 103 (Answer 5-6). However, as noted by Appellants, the limitations addressed by the Examiner in the rejection of claim 44 are actually from previously cancelled claim 11, which was not commensurate in scope with currently presented claim 44 (Br. 25-26).

Because the Examiner has failed to properly map each limitation found in these claims to the corresponding portion of the Bilbrey reference,

we agree with Appellants that the Examiner has failed to establish a prima facie case of anticipation for independent claim 44. Upon review of the citations proffered by the Examiner, and the entirety of Bilbrey, we find no basis for sustaining the anticipation rejection presented by the Examiner. Accordingly, we will reverse the Examiner's rejection of independent claim 44 as being anticipated by Bilbrey. Because claim 45 depends upon claim 44, we will also reverse the Examiner's rejection of claim 45 as being anticipated by Bilbrey.

<div align="center">Obviousness</div>

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). In addition to the findings under Graham, there must also be "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), *cited with approval in KSR Int'l Co. v. Teleflex Inc.,* 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). "[H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

Claims 25-33 and 47

We consider next the Examiner's rejection of claims 25-33 and 47 as being unpatentable over the teachings of Bilbrey.

In rejecting independent claim 25, the Examiner relies upon paragraphs 7, 101, and Figs. 19A-26 of Bilbrey, and asserts that displaying a rejection message through a graphical user interface would have been obvious, without reliance upon any secondary reference (Answer 8). In particular, the Examiner relies upon paragraph 7 in addressing the limitation "responsive to said user editing said profile, checking whether a confirm status of said email address is change pending" (Answer 7-8; *see also* claim 25).

Appellants argue that Bilbrey fails to teach checking the confirm status of an e-mail address, particularly in response to a user editing profile information (Br. 28).

In response to Appellants' arguments, the Examiner provided additional citations to Bilbrey at paragraphs 90-93 (Answer 14).

After carefully considering the evidence before us, we find that paragraph 7 of Bilbrey is merely directed to a general discussion regarding e-mail addresses and other profile information that may be updated or changed. Similarly, paragraphs 90-93 of Bilbrey merely discuss verifying an e-mail address change with the user. Upon review of all citations proffered by the Examiner, and the entirety of Bilbrey, we find nothing in Bilbrey that fairly teaches and/or suggests checking whether a "confirm status" of an e-mail address is "change pending" in response to a user editing profile information, as required by the language of claim 25. Therefore, we

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conclude the Examiner has not met the burden of presenting a prima facie case of obviousness. Accordingly, we will reverse the Examiner's rejection of independent claim 25 as being unpatentable over Bilbrey. Because claims 26-33 depend upon claim 25, we will also reverse the Examiner's rejection of these claims as being unpatentable over Bilbrey. Because we have reversed the Examiner's rejection of independent claim 44 as being anticipated by Bilbrey (see discussion *supra*), we will also reverse the Examiner's rejection of claim 47 as being unpatentable over Bilbrey, noting that claim 47 depends upon independent claim 44.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we set forth new grounds of rejection under 35 U.S.C. § 101 for claims 2, 8 and 44. In addition, we set forth new grounds of rejection under 35 U.S.C. § 112, second paragraph, for claims 19-23, 25-33, 35-38, 40-45 and 47. The basis for each is set forth in detail below.

35 U.S.C. § 101

Claims 2, 8 and 44 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Independent Claim 2

If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *In re Schrader*, 22 F.3d 290, 294-95, 30 USPQ2d 1455, 1458-59 (Fed. Cir. 1994).

Here, we find the logical "if-then" construct of claim 2 is merely an abstract idea since the claim contains no structural environment to perform the "if-then" construct. Claim 8, which depends from claim 2, fails to remedy this deficiency. Furthermore, in the event that none of the recited "if . . . then" statements are satisfied, it is unclear what the scope of the claim 2 is. Therefore, we conclude that claim 2 is directed to non-statutory subject matter. Because dependent claim 8 fails to remedy the deficiencies of independent claim 2, we also conclude that claim 8 is directed to non-statutory subject matter.

<div align="center">Independent claim 44</div>

We note that Appellants have not presented arguments invoking 35 U.S.C. § 112, sixth paragraph. Therefore, we find no hardware or machine elements expressly recited in claim 44. We note that our reviewing court has found transformation of data by *a machine* constitutes statutory subject matter if the claimed invention as a whole accomplishes a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d 1368, 1373-74, 47 USPQ2d 1596, 1600-02 (Fed. Cir. 1998). However, *State Street* did not hold that a "useful, concrete and tangible result" alone, *without a machine*, is sufficient for statutory subject matter. *Id.* at 1373, 47 USPQ2d at 1601. Therefore, we conclude that independent claim 44 is directed to non-statutory subject matter.

<div align="center">35 U.S.C. §112, second paragraph</div>

Claims 19-23, 25-33, 35-38, 40-45, and 47 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly

<div align="center">14</div>

point out and distinctly claim the subject matter which Appellants regard as their invention.

Claims 19-23, 25-33, 35-38, and 40-43

Regarding independent claims 19, 25, 35, and 40, none of these claims recite a structural environment in which the claimed displaying step may occur, rendering the claims indefinite. Dependent claims 20-23, 26-33, 36-38, and 41-43 fail to remedy the deficiencies of independent claims 19, 25, 35 and 40, respectively. Therefore, we conclude that claims 19-23, 25-33, 35-38, and 40-43 are indefinite under 35 U.S.C. §112, second paragraph.

Claims 44, 45, and 47

Regarding independent claim 44, we find there is no clear antecedent basis for the claimed means. Therefore, there is no structural environment in which the claim may occur, rendering the claim indefinite. Dependent claims 45 and 47 fail to remedy this deficiency. Therefore, we conclude that claims 44, 45, and 47 are indefinite under 35 U.S.C. §112, second paragraph.

DECISION

We have reversed the Examiner's rejections of all claims on appeal. Therefore, the decision of the Examiner rejecting claims 2, 8, 19-23, 25-33, 35-38, 40-45, and 47 is reversed. [7]

Pursuant to 37 C.F.R. § 41.50(b), we have entered new grounds of rejection against claims 2, 8 and 44 (rejected under 35 U.S.C. § 101) and

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[7] To consolidate the issues on appeal, Appellants have withdrawn claim 14 from consideration in this appeal (Br. 4). See Footnote 1.

claims 19-23, 25-33, 35-38, 40-45, and 47 (rejected under 35 U.S.C. § 112,
second paragraph).

As indicated *supra*, this Decision contains new grounds of rejection
pursuant to 37 C.F.R. § 41.50(b) (amended effective September 13, 2004, by
final rule notice 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat.
& Trademark Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b)
provides that "A new ground of rejection . . . shall not be considered final
for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, <u>WITHIN
TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise
one of the following two options with respect to the new ground of rejection
to avoid termination of the appeal as to the rejected claims:

> (1)   Submit an appropriate amendment of
> the claims so rejected or new
> evidence relating to the claims so
> rejected, or both, and have the matter
> reconsidered by the examiner, in
> which event the proceeding will be
> remanded to the examiner . . .

> (2)   Request that the proceeding be
> reheard under § 41.52 by the Board
> upon the same record . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>REVERSED</u>
<u>37 C.F.R. § 41.50(b).</u>

KIS

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